

Hearing:  
June 25, 1998

Paper No. 20  
RFC

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB                      MARCH 30,99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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On-Line Careline, Inc.  
v.  
America Online, Inc., substituted for CompuServe  
Incorporated

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Cancellation No. 25,193

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Kristin K. Jordan of Locke Purnell Rain Harrell for On-Line  
Careline, Inc.

Gail L. Morrissey of Standley & Gilcrest for America Online,  
Inc.

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Before Cissel, Seeherman and Walters,<sup>1</sup> Administrative  
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On November 28, 1995, Registration No. 1,938,569 issued  
to CompuServe Incorporated, an Ohio corporation, for the  
mark "ONLINE TODAY." The services are identified therein as  
"providing access to online computer services offering  
computer-industry news, commentary and product reviews," in  
Class 42. Use in commerce since September 1, 1984 was

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<sup>1</sup> Administrative Trademark Judge Walters has been substituted  
for Administrative Trademark Judge Simms, who, subsequent to the

claimed, and the term "ONLINE" was disclaimed apart from the mark as shown.

A petition to cancel was filed on January 4, 1996 by On-Line Careline, Inc., a Texas corporation. As grounds for cancellation, petitioner asserted that it is using the mark "ON-LINE TODAY" in connection with "services in the nature of interactive electronic communication of information, namely providing information in the fields of financial, news, sports, weather and general information and in providing round table discussions whereby users communicate their opinions on topics and in providing internet access"; that petitioner has applied to register its mark for these services<sup>2</sup>; and that respondent is not using the registered mark for the services set forth in the registration.

Implicit in petitioner's pleading is the fact that under Section 14 of the Lanham Act, paragraph 3, a registration can be canceled if the mark has been abandoned, and that failure to use a mark with the goods or services set forth in the registration constitutes abandonment of the registered mark, even if the same mark is being used as a mark for different goods or services.

Respondent's answer denied the essential allegations set forth in the petition for cancellation, and asserted as

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oral hearing in this case, recused himself from participation in the decision of this case because of a conflict of interest.

an "affirmative defense" that respondent commenced use of its registered mark long before petitioner's first use of its mark and long before the filing date of petitioner's application to register its mark. It was not explained how proving these assertions could overcome proof that the registered mark is not in use as a service mark for the services recited in the registration.

A trial was conducted in accordance with the Trademark Rules of Practice, briefs were filed by both parties, and an oral hearing before the Board was conducted on June 25, 1998.

The record in this proceeding includes testimony and discovery from Opposition No. 98,117, made of record in this proceeding by stipulation of the parties. In that opposition, the respondent in the instant proceeding is opposing the registration of the mark of the petitioner in this proceeding. In the case at hand, we have therefore considered the following: the registration which is the subject of this cancellation proceeding; the above-referenced application filed by petitioner to register "ON-LINE TODAY" for petitioner's services; respondent's responses to petitioner's interrogatories and discovery requests; the trial testimony (with exhibits) of Douglas Branstetter, respondent's Manager of Multimedia Products,

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<sup>2</sup> Application S.N. 74/466, 629, filed Dec.3, 1993, as amended, recites applicant's services as "providing telecommunications

and of Courtney Wang, petitioner's President; the discovery deposition of Mr. Branstetter, made of record by petitioner's notice of reliance; and petitioner's answers to respondent's interrogatories.

The sole issue before the Board in this proceeding is whether respondent is using the registered mark in connection with the services specified in the registration. Petitioner contends that respondent uses the mark in connection with an electronic magazine which is the electronic counterpart to a printed publication, also known as "ONLINE TODAY," but that respondent is not using the mark for the service of providing access to online computer services offering computer industry news, commentary and product reviews. Petitioner takes the position that respondent does provide access to online computer services, but that it does so under the mark "CompuServe Information Service," not the registered mark "ONLINE TODAY."

Respondent argues that its use of the mark does constitute use of the mark as a service mark for the services set forth in the registration.

Based on careful consideration of the record and the applicable legal principles and authorities, we conclude that petitioner has not established that respondent is not using the registered mark in connection with the services recited in the registration, "providing access to online

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connections to a global computer network."

computer services offering computer industry news, commentary and product reviews."

The record clearly shows that in 1983, respondent began using "Online Today" as the name of a printed magazine which provided news, software and hardware reviews, computer industry news, new product announcements and other information and advertising related to computers. In 1984, respondent began producing an electronic version of the magazine. The printed version and the electronic version coexisted until 1990. From then on, the mark "CompuServe" was used on the printed version, but the mark "Online Today" has remained in use in connection with the electronic version.

Mr. Branstetter characterized "Online Today" as "an online counterpart to CompuServe Magazine, an electronic news service that was a companion to CompuServe Magazine." (p.9 of his June 19, 1996 testimony). Later in the same deposition, he called "Online Today" "an information feature -news feature" of the information service respondent provides.

The record shows that a subscriber to respondent's "CompuServe Information Service" can, among a number of other choices, access the "Online Today" electronic magazine, and thereby gain access to respondent's online service providing computer-related news, by using the

command "GO ONLINE TODAY" or "FIND ONLINE TODAY." These so-called "menu items" are shown on a screen provided by respondent as part of its information services. In a similar sense, petitioner's Internet access services are accessed by clicking on the icon labeled "ONLINE TODAY." Both petitioner and respondent use menu items as service marks for their respective services.

We agree with respondent that petitioner is incorrect in asserting that just because "ONLINE TODAY" is shown as a menu item, it is not used to access respondent's computer information services. Menu items are the very mechanisms by which users of both petitioner's services and users of respondent's services access the respective services. As respondent points out, "access" means "to gain entry to" or "to get at," and, when used as a noun, the word means "a means of access" or "permission or ability to enter or communicate with." Webster's Collegiate Dictionary, at page 6, (10<sup>th</sup> ed. 1993). The mark is the means by which users of respondent's information services gain access to the computer-related information services provided under that menu item or heading.

Because the menu item bearing the mark is used by respondent to enable its customers to get to that section of respondent's online information services, the description of respondent's services in the registration regarding

providing access is accurate. In a very literal sense, the mark is the designation by which respondent provides access to the online computer services offering computer industry news, commentary and product reviews.

Petitioner has not established that the registered mark has been abandoned, in that petitioner has not shown that the registered mark is not used to identify the services set forth in the registration, so the petition to cancel cannot be granted.<sup>3</sup>

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<sup>3</sup> At the oral hearing on this matter, the advisability of an amendment to the recitation of services in respondent's registration was discussed. One option put forth was to strike the words "providing access to" from the beginning of the clause. Although, as indicated above, we find that the existing recitation of services is broad enough to encompass the services respondent is rendering under its mark, we state for the record that we agree that such an amendment would be an acceptable clarification. [As the testimony demonstrates, the "providing access" language may unnecessarily lead to the misconception that the service respondent provides under the mark involves providing access to the Internet. As we noted above, respondent does provide Internet access, but it does so under the mark "CompuServe."] By striking the words "providing access," respondent would avoid the possibility of creating a misunderstanding and emphasize the central focus of the services that it uses "ONLINE TODAY" to identify, online computer services offering computer industry news, commentary and product reviews. If respondent made such an amendment, it might satisfy the concerns of petitioner. No formal amendment was proffered after the hearing, however, and such an amendment is not necessary to our decision.

Cancellation No. 25,193

Decision: the petition to cancel is denied.

R. F. Cissel

E. J. Seeherman

C. E. Walters  
Administrative Trademark Judges  
Trademark Trial and Appeal Board